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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/541,733 | 10/17/2005 | Yukie Mori | 124684 | 3453 |
| 25944 | 7590 | 01/22/2008 | | |
| OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | EXAMINER BAISA, JOSELITO SASIS | |
| | | | ART UNIT 2832 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,733

Applicant(s)

MORI ET AL.

Examiner

Joselito Baisa

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/17/2005 and 11/2/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claim 6-9 and 13-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method. Applicant timely traversed the restriction (election) requirement in the reply filed on 17 October 2007. Claims 1-5 and 10-12 are considered for prosecution.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumune [JP2001085203] in view of Toshiyuki et al. [JP 10291814].

Regarding claims 1 and 10, Mitsumune discloses an electrode couple, a conductive member comprising a resin including an electric conductor, wherein the electric conductor includes fullerenes [Abstract].

Mitsumune discloses the instant claimed invention discussed above except for the fullerenes is a residual material of a synthetic carbonaceous material generated in a preparation process from which at least a part of the fullerenes is removed.

Toshiyuki discloses fullerenes generated in the preparation process from which at least a part of the fullerenes is removed [Paragraph 3].

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the preparation process of fullerene as taught by Toshiyuki to the PTC of Mitsumune.

The motivation would have been to implement a common method in the preparation of fullerene [Paragraph 6].

Regarding claims 2 and 11, Toshiyuki discloses the synthetic a carbonaceous material including the fullerenes is generated via a predetermined arc discharging method or a predetermined combustion method [Paragraph 3].

Regarding claims 3 and 12, Mitsumune discloses the preparation process of fullerene except for the claimed conductor includes oxygen atoms of 0.5 to 30 mass% and hydrogen atoms of 0.05 to 1 mass%. It would have been obvious to one of ordinary skill in the art at the time the invention was made to alter the oxygen and hydrogen content since applicant has not disclosed that a oxygen atoms of 0.5 to 30 mass% and hydrogen atoms of 0.05 to 1 mass% solves any stated problem or is for any particular purpose and it appears that the invention of Mitsumune would perform equally well with the Applicant's invention.

Regarding claims 4 and 5, Mitsumune discloses a plurality of conductor particles having resin particles formed from the resin and a conductive layer formed on the surface of the resin particles and formed from the electric conductor are piled up; wherein the electric conductor is dispersed in the resin [Paragraph 10-12].


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joselito Baisa whose telephone number is (571) 272-7132. The examiner can normally be reached on M-F 5:30 am to 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joselito Baisa
Examiner
Art Unit 2832

jsb


ELVIN ENAD
SUPERVISORY PATENT EXAMINER
01/18/08